

REMARKS/ARGUMENTS

Claims 1-45 are pending in this case, of which Claims 1, 8, and 24 are independent.

In the March 29, 2006 Office Action, the Examiner rejected independent Claims 1, 8, and 24, and corresponding dependent Claims 2-7, 9, 12-19, 21-23, 25-31, 33-41, 44, and 45, under 35 U.S.C. § 102(b) as being anticipated by Logan *et al.* U.S. Patent No. 5,732,216 ("Logan"). The Examiner rejected dependent Claims 11, 20, 32, 42, and 43 under 35 U.S.C. § 103(a) as being obvious from Logan in view of Agraharam U.S. Patent No. 6,085,231 ("Agraharam").

Applicants filed an Amendment and Response Under 37 C.F.R. § 1.111 on July 31, 2006, in which the Applicants made various amendments to the claims and traversed the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a).

On October 17, 2006, the Patent Office mailed a final Office Action in which the Examiner maintained the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a). These rejections are respectfully traversed. Applicants respectfully request the Examiner to reconsider and withdraw the current rejections in view of the following remarks.

The Rejections Under 35 U.S.C. § 102(b)

Independent Claim 1 requires an electronic message (e-mail) configured to be communicated between a sender's device and a recipient's device, where the electronic message has a sound file attached and a predetermined identifier, where the predetermined identifier both distinguishes the sound file from other files attached to the electronic message and indicates a course of action to be taken by the recipient's device with the sound file. Independent Claims 8 and 24 include similar features.

In the October 17, 2006 final Office Action, the Examiner continues to rely on Logan in his rejection of the claims under 35 U.S.C. § 102(b), while modifying some of his citations to

Logan allegedly to "better and explicitly teach . . . [the claimed] features". (Office Action, page 9). The portions of Logan currently cited by the Examiner are: col. 42, line 67 to col. 43, line 2 ("audio file attachment to an E-mail message"); col. 7, lines 30-35 ("the filenames used to specify the files in the server 125 may conveniently be formed from the program_id ... to identify and differentiate the different program segments used"); col. 15, lines 12-19 ("Program_ID"); col. 45, lines 52-54; and col. 7, lines 36-41 ("identifies the order in which downloaded program segments are to be played"). (Office Action, page 3). Applicants respectfully disagree that the newly cited portions of Logan, or any other portions of Logan, teach the features defined by Claim 1. In fact, the portions cited by the Examiner relate to different messages as opposed to a single message with an attached sound file containing all of the claimed features.

Logan describes an audio message exchange system in which multiple exchanges of information are made between a host server 101 and a player device 103 (FIG. 1), with the end result being that a user of the player device 103 can listen to audio content from host server 103 at times chosen by the user (e.g., programs and advertisements matching preferences associated with a user of player device 103) and the user can submit to host server 101 audio annotations/comments regarding the content. These multiple exchanges within the Logan system include: player device 103 uploading user information/ preferences to host server 101 (stage 203, Fig. 2, "Establish Account"), host server 101 compiling audio content matching the user preferences, player device 103 periodically contacting host server 101 to download the compiled audio content based on time of day clock 106 (col. 5, lines 45-62; "Download Compilation" 145, Fig. 1), player device 103 downloading the requested content and a recommended sequence file identifying a default order in which the audio content can be played back (which can be modified

by the user before playback begins) (col. 7, lines 36-45), a user of player device 103 accessing the player device and entering a valid password ("Accept Password" 231, Fig. 3), player device 103 allowing the user to listen to the audio content in the default sequence or in a new order specified by the user, or to end the session altogether without the audio ever being played (e.g., col. 11, line 16 to col. 12, 16), and a user of player device 103 submitting annotations and comments to audio content, which can be uploaded to host server 101 and/or stored locally by player device 103 (col. 19, lines 27-33 and "Record User's Response" 264, Fig. 3).

In the Examiner's attempt to demonstrate that Claim 1 is anticipated by Logan, the Examiner cites to multiple, different and unrelated exchanges of information that occur within the Logan system, without ever pointing to a *single* electronic message that has a sound file attached and a predetermined identifier, where the predetermined identifier both distinguishes the sound file from other files which may be attached to the electronic message and indicates a course of action to be taken by the recipient's device with the sound file as required by Claim 1. Some portions of Logan cited by the Examiner relate to downloads from host server 101 to player device 103 (i.e., col. 7, lines 30-35 and col. 7, lines 36-41), whereas other cited portions relate to processes performed solely by player device 103 (i.e., col. 42, line 67 to col. 43, line 2, col. 7, lines 30-35 and col. 15, lines 12-19). For completeness, each of the portions cited by the Examiner is addressed in turn below.

Col. 42, line 67 to col. 43, line 2: discloses that a comment/annotation generated by a user of player device 103 can be e-mailed as an audio attachment (e.g., a RealAudio file) to the e-mail address(es) of other subscribers. If it is the Examiner's position that this e-mail with attached audio comment/annotation shows Applicants' claimed electronic message, this rejection cannot hold. This portion of Logan does not disclose that the e-mail includes a predetermined identifier

for performing the claimed functions of distinguishing the sound file from other files which may be attached to the electronic message and indicating a course of action to be taken by the recipient's device with the sound file ("the comment could be transmitted as an audio file attachment to an E-mail message"; col. 42, line 67, to col. 43, line 1; emphasis supplied). Notably, Logan does not disclose that a program_id is transmitted with the e-mail, or even mention the possibility of attaching other files to the e-mail. Moreover, as described in the following paragraph, the program_ids do not meet the claimed requirements of the "predetermined identifier" set forth in Claim 1.

Col. 7, lines 30-35: describes that player device 103 can request to download specific files from FTP server 125 of host server 101. In the request, player device 103 identifies the files it wishes to download by their filenames (program_ids). The Examiner's position appears to be that this "download" of multiple files shows Applicants' claimed electronic message, and that the program_ids accompanying the files show Applicant's claimed predetermined identifier. However, this rejection cannot hold for at least the reason that the program_ids do not identify any course of action to be taken by the recipient device. Rather, the program_ids merely identify the filenames of the audio files. In fact, despite the presence of the program_ids, the recipient device may take no action with the audio files. This offends the claim language which states that the predetermined identifier "indicates a course of action to be taken by the recipient's device with the sound file" (emphasis supplied). In the Logan system, a user of the device must access the device ("Accept Password" 231, Fig. 3) and then, if the user does not override the default program sequence (col. 7, lines 36-45), the user may listen to the scheduled programming long enough to reach the scheduled playback position of the audio file. Thus, clearly the program_ids

do indicate any course of action "to be taken by the recipient's device" with respect to the sound files.

Col. 15, lines 12-19: describes a "MARK" 280 (Fig. 3) playback control that can be issued by a user of player device 103 to designate a program segment for future use. The Program_ID for that segment and the mark can be placed within usage log 215 (Fig. 2), from which the program segment can be reproduced, or forwarded as an attachment to an e-mail. If it is the Examiner's position that this e-mail with attached program segment shows Applicants' claimed electronic message, this rejection cannot hold. This portion of Logan does not disclose that the e-mail also includes a predetermined identifier for performing the claimed functions of distinguishing the sound file from other files which may be attached to the electronic message and indicating a course of action to be taken by the recipient's device with the sound file ("that segment may be . . . forwarded as an attachment to an e-mail message"; col. 42, line 67, to col. 43, line 1; emphasis supplied). Notably, Logan does not disclose that a program_id is transmitted with the e-mail, or even mention the possibility of attaching other files to the e-mail. Moreover, as described in the previous paragraph, the program_ids do not meet the claimed requirements of the "predetermined identifier" set forth in Claim 1.

Col. 45, lines 52-54: refers to the text of Logan's dependent claim 2, which states that a user of the player device can provide an audio annotation for an audio program, wherein the audio annotation includes identification data specifying a position in an audio program to which the annotation relates. With reference to the Logan specification, these comments and annotations can be uploaded from the player device 103 to host server 101 for later download by other player devices 103 downloading the same audio program. (col. 43, lines 11-15 and col. 41, lines 49-51). If it is the Examiner's position that the "download" including the audio annotation

shows Applicants' claimed electronic message, and that the identifier associated with the audio annotation shows Applicants' claimed predetermined identifier, this rejection must fail for similar reasons described above in connection with the download by player device 103 of files and associated program_ids (*See* Applicants' arguments with respect to the portion of Logan at col. 7, lines 30-35). Briefly, the identifier associated with the audio annotation does not identify any course of action to be taken by the recipient device. Rather, it merely identifies the position in an audio program to which the annotation relates. Despite the presence of the identifier, the recipient device takes no action with the audio files unless a user directs the action, which offends the claim language which states that the predetermined identifier indicates a course of action "to be taken by the recipient's device".

Col. 7, lines 36-41: describes that data (sequence file) downloaded by player device 103 from host server 101 provisionally identifies the order in which downloaded program segments are to be played, where the order is based on user preference data stored by the host server 101. The sequence file references the program segments by their program_ids (Fig. 5). The Examiner's position appears to be that a program_id meets the criteria for the "predetermined identifier" set forth in Claim 1 because the sequence file determines an order in which the program segments *might possibly* be played back and references the program segments by their program_ids. However, as is more fully described above by Applicants in connection with the portion of Logan at col. 7, lines 30-35, the user may choose not to access player device 103, may choose to override the default program sequence defined by the sequence file, or may not listen to the scheduled programming long enough to reach the scheduled playback position of any given audio file. In other words, it is the user who must take the action, not player device 103, and the user may take no action with the audio files. Again, this offends the claim language

which requires the "predetermined identifier" to indicates a course of action "to be taken by the recipient's device".

In view of the foregoing, Applicants respectfully submit that independent Claim 1 is allowable over Logan. Agraharam fails to cure the deficiencies of Logan for at least the reasons advanced in the July 31, 2006 response, which reasons are incorporated by reference herein as if fully set forth. Independent Claims 8 and 24 are allowable for at least the reasons set forth above in connection with Claim 1. As described above, a user of the Logan player device 103 is required to access the device, and even then the user may override the default program sequence defined by the sequence file, or may not listen to the scheduled programming long enough to reach the scheduled playback position of any given sound file or even listen at all. The user of player device 103 may take no action with the sound files despite the presence of identifiers in the Logan system. Thus, it is clear that the identifiers in the Logan system do not indicate a course of action "to be taken by the recipient's device" with an attached sound file.

Accordingly, the Examiner is respectfully requested to withdraw the rejections under 35 U.S.C. § 102(b) of independent Claims 1, 8, and 24. Claims 2-7, 9-23, and 25-45 depend from independent Claims 1, 8, and 24. Thus, Claims 2-7, 9-23, and 25-45 are allowable for at least the reasons stated above with respect to the independent claims. Thus, the Examiner is also requested to reconsider and withdraw the rejections of Claims 2-7, 9-23, and 25-45.

The claims currently presented are proper and definite. Allowance is accordingly in order and respectfully requested. However, should the Examiner deem that further clarification of the record is in order, we invite a telephone call to the Applicants' undersigned attorney and

agent to expedite further processing of the application to allowance.

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Respectfully submitted,


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